

REMARKS/ARGUMENTS

Claims 1-16 were pending in this application. Claims 5-7 have been allowed. No claims have been amended, added or canceled. Claim 16 is withdrawn. Hence, claims 1-4 and 8-15 are present for examination. Reconsideration of the subject application is respectfully requested.

Claims 1, 2, 4 and 8-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10, 16, 17, 21-24 and 27 of U.S. Patent No. 6,625,342 to Staple, *et al.* (hereinafter "Staple").

Claims 1-3, 9, 11, 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the cited portions of U.S. Patent No. 6,533,947 to Nasiri, *et al.* (hereinafter "Nasiri").

Claims Rejected Under The Judicially Created Doctrine Of Obviousness-Type Double Patenting

A terminal disclaimer is provided herewith, thus overcoming the rejection of claims 1, 2, 4 and 8-15 for obviousness-type double patenting.

Claim Rejections Under 35 U.S.C. § 103(a)

The applicants respectfully traverse the rejection of claim 1 since the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, and the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

With respect to the third prong of the test and the rejection of claim 1 the office action correctly states that Nasiri "does not teach that the first and second actuators are disposed

above the base layer.” Without citing an alternative reference that teaches this limitation, however, the office action appears to take official notice that the limitation is found in the prior art. The Applicants note that

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added, citing 37 CFR §1.104(d)(2)) If the office action is relying on facts within the personal knowledge of the Examiner, the Applicants respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2). Since the office action has not cited a reference in the prior art that teaches all the claim limitations, the Applicants believe that claim 1 is allowable.

Further, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to modify Nasiri to achieve the Applicant’s claimed invention. The Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) Once again it appears that the office action is relying on facts within the personal knowledge of the Examiner, in which case the Applicants respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2). Thus, for this additional reason, claim 1 is believed to be allowable.

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Reply to Office Action of March 17, 2004

PATENT

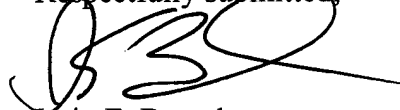
Claim 9 includes a similar limitation to claim 1 and is believed to be allowable for at least the reasons states above. The remaining claims depend from either claim 1 or claim 9 and are, therefore, believed to be allowable for at least the same reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
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